

REMARKS

Reconsideration and withdrawal of the rejections of this application and consideration and entry of this paper are respectfully requested in view of the herein remarks and accompanying information, which place the application in condition for allowance.

The Examiner is thanked for indicating that the rejection on the ground of nonstatutory obviousness-type double patenting has been withdrawn.

I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 1-19 and 22 are currently under consideration. Claims 1 and 9 are amended without prejudice, without admission, without surrender of subject matter, and without any intention of creating any estoppel as to equivalents.

Claim 1 is amended to clarify the upper parts of the sports boot, while claim 9 is amended to clarify the second material. No new matter is added.

It is submitted that the claims herewith are patentably distinct over the prior art, and these claims are in full compliance with the requirements of 35 U.S.C. §112. The amendments to the claims presented herein are not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply to clarify the scope of protection to which Applicant is entitled.

Support for the amended claim can be found throughout the specification and claims as originally filed. Support for the amendment to claim 1 can be found, for example, on page 4, lines 13-29, on page 5, lines 1-9, and in Figures 1 and 2, while support for the amendment to claim 9 can be attributed to what is known in the art.

II. THE REJECTION UNDER 35 U.S.C. § 112 IS OVERCOME

Claim 9 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particular point out and distinctly claim the subject matter which Applicant regards as the invention. The rejection is respectfully traversed.

Specifically, the Office Action alleges that the recitation of “polyester felt” in claim 9 is unclear because felt is made of wool while a felt-like material is made of polyester. According

to the Office Action, it is therefore unclear whether the intended material is wool, polyester-wool blend, or polyester.

In response, it is noted that claim 9 is amended to clarify that the second material is a polyester felt-like material. As such, it would be clear to the skilled artisan as to what is encompassed by the term “polyester felt-like material,” as the Office Action implies that “felt-like” is a term that is known in the art.

Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, second paragraph, are respectfully requested.

III. THE REJECTIONS UNDER 35 U.S.C. § 102(b) ARE OVERCOME

§ 102(b) citing Foffano et al.

Claims 1, 2, 5, 10, and 22 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Foffano et al. (U.S. Patent No. 5,995,017; hereinafter “Foffano”). Claims 3 and 4 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Foffano as evidenced by Smith (Textiles in Perspective, page 418). The Office Action maintained that Foffano relates to all elements of the present invention, and was not persuaded by Applicants’ previous arguments. These rejections are respectfully traversed and will be addressed collectively.

Initially, attention is drawn to the amended claims, wherein claim 1 clarifies that the upper parts of the sports boot formed from flat elements comprise two half-shells that cover the lateral and medial, respectively, of the wearer’s upper foot. With this in mind, it is clear that Foffano does not teach each and every limitation of the instant claims, as it does not relate to the upper foot. Rather, the alleged first and second blanks of Foffano relate to the sole and bottom face of the upper. This is clearly and distinctly different from the present invention.

Therefore it is clear that Foffano does not teach all elements of claim 1 or dependent claims 2-5, 10, and 22. Further, Smith, which was cited against claims 3 and 4, does not remedy these deficiencies in Foffano. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 102(b) are respectfully requested.

IV. THE REJECTIONS UNDER 35 U.S.C. § 103(a) ARE OVERCOME

§ 103(a) citing Foffano in view of Dassler

Claim 6 stands rejected under § 103(a) as allegedly being unpatentable over Foffano in view of Dassler (U.S. Patent No. 4,187,623). Claims 7 and 9 stand rejected under § 103(a) as allegedly being unpatentable over Foffano in view of Huebner et al. (German Patent Document No. DE 19512499C1; hereinafter “Huebner”). Also, claim 8 stands rejected under § 103(a) as allegedly being unpatentable over Foffano in view of Legassie et al. (U.S. Patent No. 5,343,638; hereinafter “Legassie”). Claims 11 and 12 stand rejected under § 103(a) as allegedly being unpatentable over Foffano in view of Brehmer et al. (U.S. Patent No. 4,793,882). Claims 11, 13-15, and 17 stand rejected under § 103(a) as allegedly being unpatentable over Foffano in view of Perotto (U.S. Patent No. 4,428,130; hereinafter “Perotto ‘130”). Finally, claims 11, 16, and 19 stand rejected under § 103(a) as allegedly being unpatentable over Foffano in view of Perotto (U.S. Patent No. 5,050,319; hereinafter “Perotto ‘319”). These rejections are respectfully traversed and will be addressed collectively.

Again, it is noted that claim 1 is amended to clarify that the upper parts of the sports boot formed from flat elements comprise two half-shells that cover the lateral and medial, respectively, of the wearer’s upper foot. As asserted above, Foffano does not teach or suggest that the alleged flat elements in Foffano will form two half-shells that cover the lateral and medial of the upper foot, since Foffano relates to the sole and bottom surface of the upper. Clearly, the present invention and Foffano relate to distinctly different aspects of the sports boot, and it would not have been obvious to apply the method of Foffano relating to the sole of the boot to parts of the boot corresponding with the upper foot. Therefore, it is clear that Foffano does not render the present invention unpatentable, as it does not teach or suggest every claim element, and it would not have been obvious to try and use Foffano in applications relating to other parts of the boot.

With this in mind, the combination of Foffano with the other cited references also do not render the rejected claims unpatentable. Dassler relates to a sports shoe and is cited for the purpose of allegedly disclosing a thickness range for the rubber sole. Huebner relates to a shoe with a cap in the toe region and was cited for allegedly disclosing polyester felt in the shoe. Legassie relates to a shoe comprising chambers, and was cited for its alleged disclosure of using elastic fabric in the shoe. Brehmer relates to a process of screen printing on shoes. Further, Perotto ‘130 was cited because it allegedly relates to a method of affixing an eyelet element to an upper before assembly. Perotto ‘319 allegedly relates to attaching a tongue to an inner lining in a

boot. Clearly, none of the references remedy the deficiency in Foffano, i.e., these references do not teach or suggest flat elements forming the upper foot using the methods of the present invention. In addition, none of the references teach or suggest trying to apply the method of Foffano to another part of the shoe other than the sole.

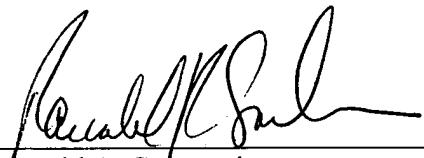
Thus, none of the combinations of references render the present invention unpatentable. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are respectfully requested.

CONCLUSION

In view of the remarks and amendments herewith, the application is in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date, and, the Examiner is invited to telephonically contact the undersigned to advance prosecution.

Respectfully submitted,
FROMMER LAWRENCE & HAUG LLP

By:



Ronald R. Santucci
Reg. No. 28,988
Telephone: (212) 588-0800
Facsimile: (212) 588-0500